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10/813,462	03/30/2004	Richard F. Stockel		4677

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RICHARD F. STOCKEL
475 ROLLING HILLS ROAD
BRIDGEWATER, NJ 08807

EXAMINER

KOSLOW, CAROL M

ART UNIT PAPER NUMBER

1755

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,462

Applicant(s)

STOCKEL ET AL

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no teaching in the specification of the claimed combination of glycols, glycol esters and glycol ester. There is no teaching in the specification of the claimed combination of nonionic and anionic surfactants. Applicants can insert the missing claimed subject matter into the specification to overcome this objection.

The disclosure is objected to because of the following informalities: On page 7, line 18, "desensitizing" is misspelled. On page 8, line 4, "ph" should be "pH". Appropriate correction is required.

Claims 4-7 are objected to because of the following informalities: "ph" should be "pH" in all of these claims. Claims 6 and 7 are missing the required period. Appropriate correction is required.

Claims 4, 6, 7, 12, 15 and 19-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 4 and 6 teach the acidic pH range is about 3.2 to about 5.5, but the specification teaches on page 7 an acidic pH range between 3.2 and 4.8. Page 8 teaches the neutral fountain solution contains the ingredients listed on page 7, but claim 7 does not include the disclosed chelating agent, the biocide and the desensitizing polymer. The claimed amounts of the buffering system and desensitizing polymer are different from those on page 7. The amounts in claims 20-22 polymer are different from those on page 7. These discrepancies need to be corrected.

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Claims 1, 3-7, 9 and 11-22 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Subject matter that is critical or essential to the practice of the invention, but not included in the claims means the claims are not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Page 2, line 21 through column 3, line 4 teach the molecular weight of the polyethylene oxide is critical to the practice of the invention and that this molecular weight is about 200,000 to about 7,000,000. This should appear in the independent claims.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3-7, 9 and 11-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: The molecular weight of the polyethylene oxide, which the specification indicates as critical to the invention. Claim 2 recites the limitation "the molecular weight". There is insufficient antecedent basis for this limitation in the claim or in claim 1 from which it depends. In claims 2-5, the preamble "The polymer" does not correspond to the preamble of claim 1, from which claims 2-5 depend. The preamble in claims 2-5 should be "The method as described in claim 1". In claim 3, the effective amount is not positively stated due to the phrase "can range". It is suggested to replace "can range" with "is". Claims 4 and 5 are indefinite and thus need to be reworded. For example, claims 4 and 5 should be as "The method as described in Claim 1 where the aqueous fountain solution has a pH in the range of about...". Claims 6 and 7 are indefinite since it is the fountain solution that has

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the claimed pH, not the water. Claims 6 and 7 are indefinite as to the actual composition of the buffering system. These claims imply the buffering system is a mixture of an acid and salt, but page 3 teaches the buffering system is an acid or salt. In claim 7, it is unclear if d and g are the same or not. Finally, the amounts of d and h in claim 7 are not defined. Since the composition of the fountain solutions in claims 6 and 7 are indefinite, the dependent claims 8-22 are indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 05-286279.

This reference teaches an aqueous fountain solution comprising 10-500 ppm of a polyethylene oxide. The examples teach fountain solutions of polyethylene oxide having a molecular weight in the range of 1,700,000-2,200,000 or 4,300,00-4,800,000. While the reference does not teach the polyethylene oxide polymer is used to reduce piling, this function would be inherent in the taught fountain solution. The reference teaches the claimed method.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 3,625,715.

This reference teaches an aqueous fountain solution comprising polyethylene oxide. The exemplified compositions do not contain any acidic or basic components and thus the fountain solution is a neutral solution with a pH of about 7. While the reference does not teach the polyethylene oxide polymer is used to reduce piling, this function would be inherent in the taught fountain solution. The reference teaches the claimed method.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 3,625,715 or JP 05-286279.

The references teach an aqueous fountain solutions comprising a polyethylene oxide. JP 05-286279 teaches fountain solutions of polyethylene oxide having a molecular weight in the range of 1,000,000-10,000,000. U.S. patent 3,625,715 teaches fountain solutions of polyethylene oxide having a molecular weight in the range of 50,000-150,000. While the reference does not teach the polyethylene oxide polymer is used to reduce piling, this function would be inherent in the taught fountain solution. These molecular weight ranges overlap the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The references suggest the claimed method.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 91,601.

This reference teaches an acidic aqueous fountain solution, having a pH in the range of about 2-5, comprising 0.005-1 wt% (50-10,000 ppm) of a polyethylene polymer. While the reference does not teach the polyethylene oxide polymer is used to reduce piling, this function would be inherent in the taught fountain solution. The molecular weight range and pH range

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overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed method.

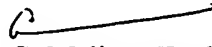
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
May 20, 2005


C. Melissa Koslow
Primary Examiner
Tech. Center 1700